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10/086,316	03/01/2002	James R. Fore SR.	4287-008	8488
24112	7590	08/04/2004	EXAMINER	
COATS & BENNETT, PLLC P O BOX 5 RALEIGH, NC 27602			HAUGLAND, SCOTT J	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/086,316  
Filing Date: March 01, 2002  
Appellant(s): FORE ET AL.

**MAILED**

AUG 04 2004

**GROUP 3600**

Edward H. Green, III  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 26, 2004.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 10-16 and 22-24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,368,245	Fore	11-1994
3,516,111	Heyman	12-1967

5,520,347	Bass et al	5-1996
4,057,203	Newman et al	11-1977

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10 and 22 are rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on 1/23/04.

Claims 10-16 and 22-24 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 1/23/04.

Claims 17-19 and 21 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 1/23/04.

**(11) Response to Argument**

Applicants argue at page 6, lines 6-10 of the brief that the cable retainer 36 of Fore is not a section of the outer surface of the flange 32 defined by a slit in the surface. However, Fore discloses a surface that includes the outer surface of cable retainer 36 and the outer surface of flange 32. The surface is contiguous, although, the claims do not require this. This surface is clearly divided into two sections (the surface of the flange 32 and the surface of the cable retainer 36). A slit divides the two sections as discussed below.

Applicants, in the next paragraph, argue that the space separating the flange and cable retainer surfaces is not a slit. It is noted that a slit as defined by Webster's Dictionary and The American Heritage Dictionary is not required to be straight. E.g., The American Heritage Dictionary defines a slit as "A long, narrow cut, tear, or

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opening". It is possible to have a curved slit. The spaces between cable retainer 36 and the flange 32 of Fore meet this definition of a slit at least for the following reasons: First, the opening that lies in the plane of flange 32 and is defined on three sides by the flange and on one side by the base of the cable retainer 36 (attached to the flange) is a long and narrow opening. It is also straight. Second, the spaces bounded by the long edges of the opening in flange 32 and the adjacent long sides of the cable retainer 36 are long and narrow openings.

In the first and second paragraphs of page 7 of the brief, Applicants argue that the Examiner has admitted that the cable retainer of Fore is distinct from the cable retainer recited in claims 10 and 22 and that the Examiner has admitted that Fore does not disclose a cable retainer including a surface divided by one or more slits that form at least two sections with at least one of the two sections being deflectable.

However, this is not correct. The Final Office Action stated that "Fore does not disclose a cable retainer including a slit surface that has a series of deflectable sections." Claims 10 and 22 include no such requirement. The Final Office Action does not imply that Fore fails to anticipate claims 10 and 22. Claims 10 and 22 are anticipated by Fore. Claims 10 and 22 would have been obvious from a combination of Fore and Heyman even if the cable retainer 36 of Fore (relied upon in the 35 U.S.C. 102 rejection) were not present. That is, the rejection of claims 10-16 and 22-24 under 35 U.S.C. 103 does not rely on the cable retainer 36 of Fore to meet these claims.

Regarding the rejection under 35 U.S.C. 103 based upon Fore and Heyman, Applicants argue (page 8) that the references are non-analogous. It is noted, however,

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that both are related to the field of cable handling and installation. The pay-out tube disclosed by Fore is for use in a cardboard cable container from which cable to be installed is pulled out through the pay-out tube. Heyman discloses a bushing for securing and supporting electrical cables that pass through walls or panels (col. 1, lines 21-38). A cable to be installed is inserted through the bushing and is supported by flexible supports 7.

Applicants' arguments beginning on page 8 of the brief do not address the obviousness of the combination of Fore and Heyman. They merely contrast a combination that is taught by Fore and Heyman, which meets the rejected claims, with a specific instance of the invention disclosed by Applicants. The claims require the cable retainer to be adapted to be disposed exteriorly of a cable container (claim 10) or require the step of retaining an end portion of cable outside the cable container (claim 14), but do not exclude a device or method involving a cable retainer that is separate from the cable container.

Applicants argue (page 9, line 13, et seqq.) that non-dispensing use is the sole purpose of cable retainer 36 of Fore and of Applicants' invention. However, it is noted that no such limitation is present in the claims. Further, in an obvious process of installing cable pulled from a box of cable such as disclosed by Fore, an end of the cable leading from the box would be inserted through a bushing disclosed by Heyman. Upon insertion of the cable end into the bushing the cable end would be retained by it as taught by Heyman. The cable could easily be left in that state indefinitely or until it was desired to resume the process and the cable would effectively be stored in that

configuration. Nothing about the structure of Fore or Heyman prevents their non-dispensing use together.

Applicants argue (pages 10 and 11) that there is no motivation for combining Fore and Heyman and that the Examiner has used impermissible hindsight. However, as noted above there is clear motivation to use the devices of Fore and Heyman together. They are related to the same field and to the problem of cable installation. Their use together is suggested by the fact that they address related portions of a process of installing cable in a building or other structure. They are so closely related and their teachings so compatible that they can be used together without modification of their structures.

In the second full paragraph of page 11, Applicants assert that there is an error or inaccuracy in the Examiner's rejection of claims 14-16. However, as noted above, a length of cable that extends from a box of cable disclosed by Fore would have its free end retained by a bushing disclosed by Heyman during an obvious cable installation process. It is noted that the installation process described by Applicants (cutting a length of cable before installation) would not be desirable in most cases, as would be appreciated by an ordinary artisan, due to the inherent inaccuracy of or difficulty in determining the required length of cable before installing it.

Regarding the rejection of claim 17 as being obvious from Bass et al and Newman et al, Applicants argue that the ribs on the pay-out of Applicants' invention are nonintersecting. However, the pay-out tube of Bass et al has ribs 66 that engage ribs 67 and ribs 66 that do not. Note Figs. 3 and 6. None of ribs 66 intersect each other. In

addition, the composite ribs formed by 66 and 67 to not intersect any other ribs.

Therefore, Bass et al discloses this limitation of claim 17.

Applicants further argue (page 13) that there is no motivation to modify the pay-out tube of Bass et al to make its cross section elliptical because Bass et al discloses a figure-8 wound coil and does not disclose an elliptical pay-out tube. The motivation is provided by Newman et al. Newman et al also discloses a pay-out tube for material wound in a figure-8 pattern. Newman et al teaches that an elliptical pay-out tube fits more efficiently in the diamond shaped opening of an ordinary figure-8 wound package. Modifying the pay-out tube to make its cross section elliptical would, therefore, have been obvious from the teachings of Newman et al. The teachings of Newman et al do not contradict and are not incompatible with those of Bass et al since Bass et al is not concerned with optimizing the fit of a pay-out tube in the pay-out opening of a wound coil. Bass et al is directed to other perfecting features. It is not necessary for a patent to disclose all obvious modifications of an invention.

For the above reasons, it is believed that the rejections should be sustained.



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Respectfully submitted,

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July 27, 2004

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